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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,730	01/24/2001	Steve Buckley	YOR92000694US1	2263

30743 7590 04/19/2005

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,730

Applicant(s)

BUCKLEY ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10,12-17,20-22,25-34 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10,12-17,20-22,25-34 and 37-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 12/22/2004 has been entered.

Claim Rejections - 35 USC § 112

1. Claims 43, 3-10, 12-17, 20-22, 44, 25-34, 45, 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 43, 44, 45, it's not clear the relationship of element (c) "in performing a qualitative assessment on a selected business measure based on benchmarks" to the remaining elements of the claim. There is no discussion of "assessment" to the body of the claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 43, 4-10, 12-17 (method¹), 44, 25-34 (apparatus¹), and 45, 37-42 (software product¹) are rejected under 35 U.S.C. 103(a) as being unpatentable over CALVER in view of SARNO.**

As for Independent Method claim 43, CALVER discloses a method for providing business solutions over an interactive communications medium, comprising the steps of:

(a) permitting a user to select an industry from a set of industries electronically stored in a database for which business solutions are available {see Fig. 16, 0054, 0060};

(b) permitting a user to select one (or a plurality) of business measures from a set of business measures electronically stored in a database, wherein each business measure is associated with a particular financial aspect of a selected industry {see Fig. 16, 15, 0054, 0056, 0057};

(c) using a computer to assist a user in performing a qualitative assessment on a selected business measure based on benchmark relevant to a selected industry {see Fig. 15, 16, 0138, 0139};

(d) presenting a dynamic set of questions from among questions electronically stored in a database which relate to selected business measures of a selected industry, such that questions for a user can be applied to a database contents for a plurality of purposes, one of the purposes being to permit a next question to be based on a previous question and a previous answer, and permitting a user to answer said dynamic set of questions {see 0061, 0063, 0070, 0077};

(e) using a computer to analyze a user's answers to said dynamic set of questions and to determine general or scientific business solutions based on an analysis of said user's answers, and providing said general or specific business solutions to said users {see 0072, 0075, 0138, Figs. 15, 16}; and

(f) using a computer to analyze a specific business solution and to perform a financial analysis based on a selected industry, business measures and associated benchmarks {see Fig.16, 0055, 0057 "e.g. finance calculators", 0072, 0085, 0138-0142}.

CALVER fairly teaches the claimed invention except for an additional limitation in step (f) of wherein the financial analysis parameter is a well known parameter, return on investment (or ROI).

Note: Applicant's response/argument of 12/22/04, pages 13-14, indicated that CALVER fails to teach 2 elements, (1) one of which CALVER does not provide for questions to be generated based on answers to previous questions and (2) calculation

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of ROI in step (f). However, as for the (1st) element, this is fairly taught in CALVER in [0063, 0061-0062, 0070]. Therefore, the only missing element in CALVER is a well known business analysis parameter, i.e. (ROI).

In another method and apparatus for business financial analysis, SARNO is merely cited to teach many well known business analysis parameters or types such as Return on Investment (ROI), Cost of Ownership (COO), and Cost/Benefit analysis (C/B), Rate of Return (ROR) {see 0112, 0116, 0121}. It would have been obvious to modify the teaching of CALVER by including well known specific business financial calculation parameter such as (ROI) or (ROR) as taught by SARNO to accurately analyze the business analysis and solution {see 0117}.

As for dep. claim 3 (part of 43), which calls for a specific industry code which is well known in industry, this is taught in CALVER {0056, 0057, 0071 or 0072}.

As for dep. claim 4 (part of 1), which calls for a general business solution, this is taught in CALVER {Fig. 16, 0054, 0070-0071}.

As for dep. claims 5-7 (part of 1), which calls for the provision of general business solution based on a set of rules, type of solution and ranking of solution, these are inherently taught in CALVER {[0053-0058, or 0138-0142, Fig. 15-16} to provide a real useful, targeted solutions that take my business to the next level, or reduce my costs or grow my business or protect my businesss.

As for dep. claim 8 (part of 1), which calls for the storing of the input information, this is inherently included in CALVER Figs. 2-5.

As for dep. claim 9 (part of 1), which calls for a specific business criteria/measure, i.e. inventory, revenue, etc., this is shown on CALVER Fig. 15, 16, 0054, 0085 “revenue of 1.8 million”, or 0138.

As for dep. claim 10 (part of 1), this is taught in CALVER [0052, 0060, 0061 or 0062].

As for dep. claims 12-14 (part of 1), which deals with types of rules for determining next question, i.e. based on the previous answer, or duplicate of previous answer, etc., these are inherently included in the teachings of CALVER [0060-0063, 0069-0076] in order to obtain targeted and useful information.

As for dep. claim 15 (part of 1), which deals with type of metrics, i.e, quantitative metrics, this is inherently included in CALVER Fig. 15, 16, [0070-0071, 0138-0142].

As for dep. claim 16 (part of 1), which deals with type of answer, i.e, financial analysis, this is shown in CALVER Fig. 15, 16, [0057, 0072, 0085, 0138-0142].

As for dep. claim 17 (part of 1), which deals with well known/conventional type of financial analysis, i.e, ROR, ROI or ROA, this is taught in SARNO [0112, 0116, 0121].

6. **As for Independent Apparatus¹ claim 44**, which is merely system (or means for) to carry out the steps of Method claim 1 above, it is rejected over the means to carry out the method/steps of claim 1 above as taught by CALVER / SARNO above (substituting “means for” for “step of”).

As for dep. claims 25-27 (part of 44), which have similar limitations as in dep. claims 4-5, 8 respectively above, they are rejected for the same reasons set forth in claims 4-5, 8 above.

As for dep. claim 28 (part of 44), which has similar limitation as in dep. claim 16 above, it's rejected for the same reason set forth in claim 16.

As for dep. claim 29 (part of 44), which has similar limitations as in dep. claims 2 & 15 above, it's rejected for the same reason set forth in claims 2 and 15 above.

As for dep. claims 30-31 (part of 44), which have similar limitations as in dep. claims 5, 22 above, they are rejected for the same reason set forth in claims 5, 22 above.

As for dep. claim 32 (part of 44), which have similar limitations as in dep. claims 12-13 above, it's rejected for the same reason set forth in claims 12-13 above.

As for dep. claim 33 (part of 44), which has the same limitation as in dep. claim 15 above, it's rejected for the same reason set forth in claim 15.

As for dep. claim 34, this is shown in Figs 15-16.

7. As for the machine readable medium containing code for instructing a computer to provide business solutions over an interactive communications medium in claims 43, **37-42** for carrying out the method of claims 43, 4, 7, 9, 21, 16, and 22 respectively, they are rejected for the same reason set forth in claims 1, 4, 7, 9, 21, 16, and 22, respectively above.

Note that the teaching of CALVER is carried out using the Internet or web (see Fig. 16 for summary), so program modules are inherently included to carry out any steps {as discussed in "Architecture", [0119-0130]}.

8. Claims 5-7, 12-14 (part of 43), 25-27, 32-33 (part of 44), 37-38, 40 (part of 45) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over CALVER/SARNO in view of FRIEDMAN.

The teachings of CALVER/SARNO is cited above. As for dep. claims 5-7, 12-14, 25-27, 32-33, 37-38, 40, FRIEDMAN discloses the benefits of optimization of specific problem parameters or variables and different rules based model on Figs. 2-3, col. 4, lines 10-40, col. 6, lines 45-62. It would have been obvious to modify the teachings of CALVER/SARNO by using rules based model as taught by FRIEDMAN to obtain the benefits of optimization of the specific problem parameters or variables. Note that the use of other similar or equivalent mathematical model or rules based would have been obvious as mere using other similar or equivalent model or rules to achieve similar results. Note that on Figs. 2-4, FRIEDMAN fairly teaches the concept of optimization of the desired business parameters, i.e. resource allocation, direct transportation cost, network problems, inventory, sequential policy, generic model, queuing theory, etc.

Response to Arguments

9. Applicant's arguments with respect to the rejections of claims 1-42 under 102 (e) especially with respect to part (1) is not persuasive in view of the examiner's response in the "Note: shown in paragraph No. 5" above. As for the only missing element in CALVER is a well known business analysis parameter, i.e. (ROI), in which examiner

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cites SARNO to disclose a well known business analysis parameter that is inherently included in the financial calculation of CALVER [0057].

10. The rejections of claims 1-42 under 35 USC 101 are withdrawn due to applicant's amendments of the independent claims and cancellation of independent claims 1, 18, 23, 29 and 35.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims are allowed.

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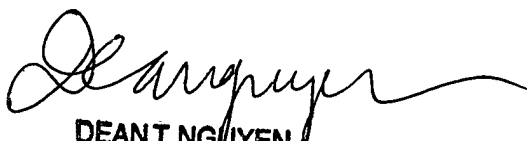
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053 or (571) 272-6806 (by April 15, 2005). My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtm
April 1, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER